MODIFIED PTO/SB/33 (09-08)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

		Docket Number Q96579
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on	Application Number 10/590,008	Filed August 21, 2006
	Confirmation Number: 6887 First Named Inventor Satoshi KADOKAWA	
Signature Typed or printed name	Art Unit 3656	Examiner YABUT, DANIEL D

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

☑ The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

CORRESPONDENCE ADDRESS

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65565

CUSTOMER NUMBER

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☑ attorney or agent of record. Registration number 32,778

☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Brian W. Hannon/
Signature

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Telephone number

April 28, 2011
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 form is submitted.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Satoshi KADOKAWA, et al.

Appln. No.: 10/590,008

Confirmation No.: 6887

Filed: August 21, 2006

For: ROLLING SLIDING PARTS

Docket No: Q96579

Group Art Unit: 3656

Examiner: YABUT, DANIEL D

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated April 27, 2011, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

The Examiner continues to reject claims 1-30 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sada (U.S. Patent No. 5,885,690). Applicants strongly disagree for the following reasons.

Of the claims pending in the application, there are three independent claims - claims 1, 2 and 3. The rest of the claims are dependent on these claims.

Each of claims 1-3 requires a specific range for the occupation ratio of rolling sliding parts (claim 1: 90% to 100%; claim 2: 80% to 100%; and claim 3: 50% to 100%). The meaning of the term "occupation ratio" is specifically defined as:

- wherein the occupation ratio is calculated by dividing a sectional area of a virtual plane in a plane direction at a portion that is positioned at a specific depth (claim 1: 1.0 μm; claim 2: 1.5 μm; and claim 3: 1.0 μm) from the outermost surface position by an area of an overall surface of a portion that contacts the other member
- wherein the outermost surface position is defined as a position of a highest portion out of fine roughnesses existing on the surface"

As repeatedly asserted during the prosecution of this case, Applicants maintain that Sada does not teach or suggest the claimed occupation ratio because it does not disclose calculating a sectional area of a virtual plane in a plane direction at a portion that is positioned at a specific depth from the outermost surface position.

On this point, the Examiner asserts that Sada teaches at col. 3, lines 33-37 that "Rpk = Ry-depth = 2.22 micrometers - 2 micrometers = 0.22 micrometers" *See* Office Action dated October 28, 2010 at page 2. Yet, there is no such statement or suggestion in Sada. Thus, Applicants submit that the Examiner's analysis is unsupported by the teachings of Sada.

To help demonstrate this, Applicants have attached a drawing in which Figs. 1 A and 1B of Sada are arranged side-by-side such that the highest point T and the lowest point V are aligned to their respective cut level P, i.e., P 0% at the highest point T and P = 100% at the lowest point V.

As shown in the drawing, it is clear that the expression of "Rpk = Ry - depth" is meaningless. That is, while Rpk = Ry - Ra - Rb = Ry - (Ra Rb), (Ra + Rb) is not equal to

"depth". In fact, Depth, Rpk and Ry are not in a related in a way that can be expressed by a mathematical formula. Depth is a constant number in each independent claim, and not a variable or a function.

Regarding the Examiner's response in the paragraph beginning at the penultimate line in page 5 of the Office Action, Applicant submits that the disclosure of Sada does not provide any teaching or suggestion that would allow a person of ordinary skill in the art to derive the specific ranges of the occupation ratio at the specific depths recited in the claims 1-3.

Where does Sada disclose the sectional area of a virtual plane in a plane direction at a portion that is positioned at a depth of 1.0 μm, 1.5 μm or 1.0 μm from the outermost surface position, as is necessary to arrive at the claimed occupation ratio? There is no such such disclosure.

Thus, it is submitted that Sada does not anticipate, or render obvious, any of the claims of the subject application.

Respectfully submitted,

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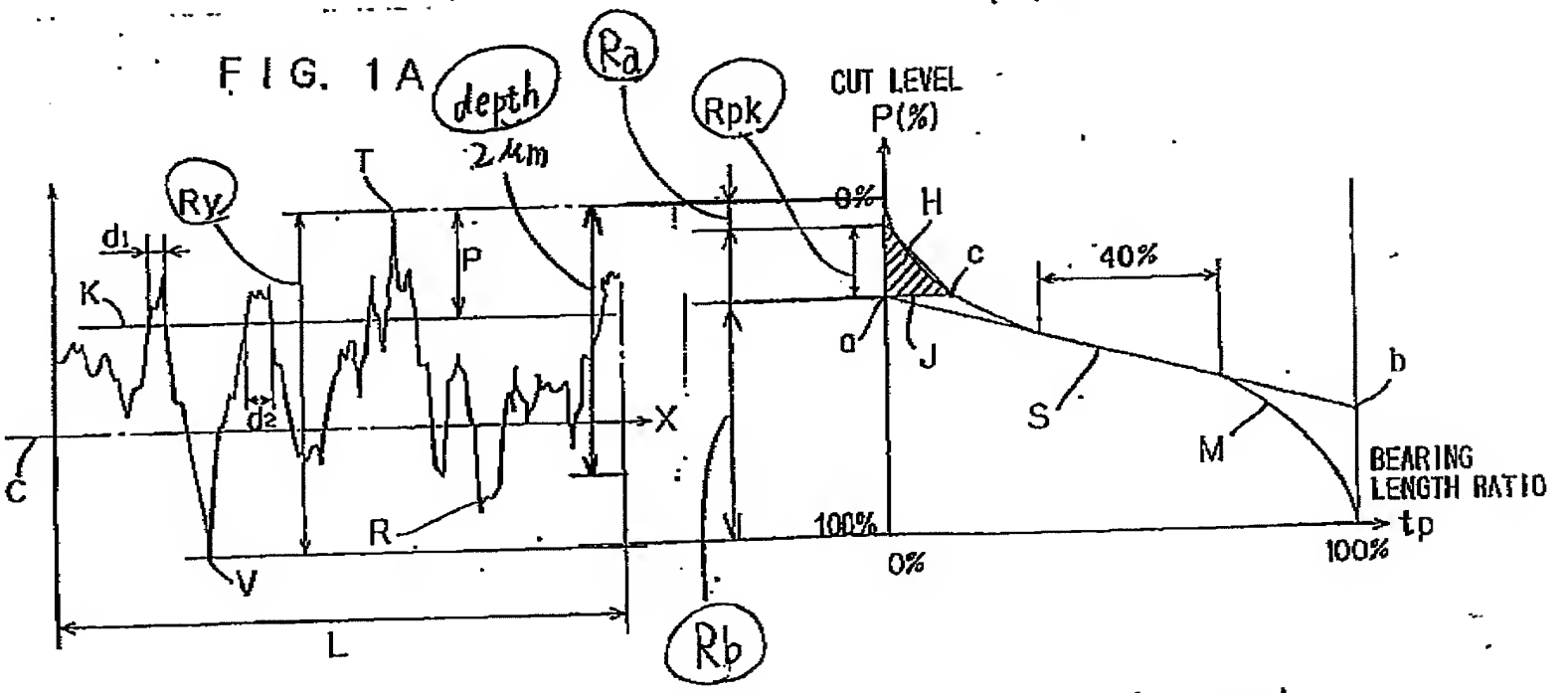
FIG. 1A

FIG. 1B



$$R_{pk} = R_y - R_a - R_b = R_y - (R_a + R_b) \neq R_y - depth$$